

Serial No. 10/662,947

REMARKS

The sole issue remaining in the outstanding Office Action is an objection by the Examiner that the claims are directed to a non-elected invention. It does not appear that the Examiner carefully reviewed the arguments raised in the last Amendment. On page 3 of the Office Action, the Examiner asserts that "Applicant has cited several [cases] dealing with estoppel of claimed subject matter based on broadening or narrowing of the claimed subject matter, however, as stated above the pending claims are declared improper on the ground of [the] claims directed to [a] non-elected invention and not on the ground of broadening or narrowing."

The Examiner's statement indicates that there is some confusion. The case law cited previously deals with improper recapture, not improper broadening or narrowing. The Examiner refers to non-elected inventions. However, the non-elected invention rules are part of the prohibition of recapture. The general rules for recapture govern whether claims are improper. One application of the general rules is for non-elected inventions. Accordingly, the case law cited previously is on-point.

On page 2 of the Office Action, the Examiner cites several cases. Each of these cases relates to the filing of a Reissue Application to obtain protection on non-elected claims. In each of the cases cited by the Examiner, it appears that the claims presented on Reissue were the same or substantially the same as the non-elected claims. Certainly, the claims of the present application are not the same or substantially the same as the non-elected claims. Accordingly, the cases cited by the Examiner are not directly applicable. Instead, the general rules regarding recapture govern. It is improper to look only to the specific non-elected invention rules. They do not apply.

The cases cited by the Examiner relate to a particular recapture rule of attempting use Reissue to obtain protection of non-elected claims. The more general rule is stated in MPEP § 1412.02 (Copy enclosed). The more general rule must be used because the claims are different from the non-elected claims. § 1C1(b) indicates that if Reissue claims are narrower in scope than the claims cancelled from the original application by inclusion of a limitation added to define the original application claims over the prior art, then there will be no recapture.

For the convenience of the Examiner, the arguments presented on May 2, 2007 are reproduced below.

The Examiner asserts that the claims are directed to prohibited recapture. The general rules for recapture were established in *In re Clement*, 131 F. 3d 1464, 45 U.S.P.Q 2d 1161

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(Fed. Cir. 1997) and *Ball Corp. v. United States*, 729 F.2d 1429, 221, U.S.P.Q.289 (Fed. Cir. 284). These cases set forth that:

Claims narrower in all aspects - No estoppel

Claims broader in all aspects - Estoppel

Claims narrower in some aspects and broader in some aspects:

Narrowing aspect related to patentability - No estoppel

Narrowing aspect not related to patentability - Estoppel

Independent claims 15 and 16 recite that each of the slits has a first region with a first width and a second region with a second width, the first width being less than the second width. According to claims 15 and 16, the springy portion of each contact pin has a width less than the second width. The non-elected claims of the original application made no mention of a springy portion of a contact pin having a width less than a second width. Accordingly, claims 15 and 16 are narrower in this aspect.

As described below, the narrowing aspect is related to patentability. Specifically, in the parent application, a prior art rejection was raised based on U.S. Patent No. 5,713,751 to Fukunaga.

In an Amendment filed on February 12, 2001, the patented claims were distinguished based on the claimed engagement portions, which retain the contact piece. The following is an excerpt of the arguments made on February 12, 2001.

Applicant teaches an IC socket having a contact pin with a movable contact piece and a stationary contact piece to contact upper and lower sides, respectively, of an electrical lead of an electrical part. The stationary contact piece includes an engagement portion that engages a complimentary engagement portion of the socket body. This engagement limits upward movement of the stationary contact part, which could cause deterioration of the electrical contact with, or deformation of the lead.

For example, as shown in Figure 2, the stationary contacting piece (15e) includes an engagement portion (15g) to engage with an engaging portion (19d) of the seating plate (19) of the socket body.

Fukunaga does not disclose an engagement portion in either the socket body (12) or the stationary contact piece (15G) of the contact pin that would prevent upward movement of the stationary contact piece (See Figures 8A, 8B, 9A, 9B, and 12).

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The second embodiment has somewhat different engagement portions from the first embodiment. In the second embodiment, the contact pins 25 are received within slits 23d (see Fig. 11) provided in the socket body 23. The upper slit portion 23e is narrower than the lower slit portion 23f. See column 9, lines 11-23 of the patent. Referring to Fig. 9, the springy portion 25c of the contact pin 25 is narrower than the lower slit portion 23f. The varying widths (23e narrower than 25c) retain the contact pin 25 within the socket body 23 in a similar manner as the engagement portions retain the contact pin of the first embodiment. This feature was not claimed in cancelled claims 5-7. The narrowing aspect of the claims, the springy portion having a width less than the second width, relates to patentability (the Fukunaga prior art rejection). The case law is clear that if the claims are narrower and in aspect related to patentability, estoppel does not apply. Therefore, the recapture rejection should be withdrawn, at least as it concerns claims 15 and 16.

With regard to claims 17-20, these claims are directed to a mounted electrical part. The original application did not contain claims directed to a mounted electrical part. Clearly a mounted electrical part is different from a socket. The election requirement was not directed to this invention, and accordingly, the recapture rejection should not apply to claims 17-20.

With regard to claims 21 and 22, these claims are directed to a method of mounting an electrical part. 35 U.S.C. § 101 states whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof may obtain a patent therefor. Section 101 defines the different categories of patentable subject matter. Processes are clearly separated from machines and manufactures. The original application contained no claims directed to the process class of statutory subject matter. It is submitted that had the original application contained claims 21 and 22, the Examiner would have restricted claims 21 and 22 from non-elected claims 5-7. It is well established that reissue can be used to pursue protection directed to another class of statutory subject matter if the application did not contain claims directed to such other class. Claims 21 and 22 are to achieve this completely legitimate purpose. Accordingly, the recapture rejection should be withdrawn with regard to these claims.

In view of the foregoing, it is respectfully requested that the Examiner review the rules governing prohibited recapture (and non-elected invention recapture). It is submitted that the claims do not violate the recapture rule (or any specific subset of that rule relating to non-elected inventions). Because the previous arguments were not considered, it is submitted that if the application is not allowed, the finality of the present Office Action should be withdrawn.

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There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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Oct 17 2007

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Date: October 17, 2007



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1412.02 Recapture of Canceled Subject Matter [R-5] - 1400 Correction of Patents

1412.02 Recapture of Canceled Subject Matter [R-5]

A reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. >*North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005), <*Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1974); *In re Richman*, 409 F.2d 269, 276, 161 USPQ 359, 363-364 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

I. THREE STEP TEST FOR RECAPTURE:

In Clement, 131 F.3d at 1468-70, 45 USPQ2d at 1164-65, the Court of Appeals for the Federal Circuit set forth a three step test for recapture analysis. In *Pannu*, 258 F.3d at 1371, 59 USPQ2d at 1600, the court restated this test as follows:

Application of the recapture rule is a three-step process.

The **first step** is to 'determine whether and in what aspect the reissue claims are broader than the patent claims.'....

'The **second step** is to determine whether the broader aspects of the reissued claim related to surrendered subject matter'

Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. [Emphasis added]

A. The First Step - Was There Broadening?

In every reissue application, the examiner must first review each claim for the presence of broadening, as compared with the scope of the claims of the patent to be reissued. A reissue claim is broadened where some limitation of the patent

claims is no longer required in the reissue claim; see MPEP § 1412.03 for guidance as to the nature of a "broadening claim." If the reissue claim is not broadened in any respect as compared to the patent claims, the analysis ends; there is no recapture.

B. The Second Step - Does Any Broadening Aspect of the Reissued Claim Relate to Surrendered Subject Matter?

Where a claim in a reissue application is broadened in some respect as compared to the patent claims, the examiner must next determine whether the broadening aspect(s) of that reissue claim relate(s) to subject matter that applicant previously surrendered during the prosecution of the original application (which became the patent to be reissued). Each limitation of the patent claims, which is omitted or broadened in the reissue claim, must be reviewed for this determination. This involves two sub-steps:

1. The Two Sub-Steps:

(A) It must first be determined whether there was any surrender of subject matter made in the prosecution of the original application which became the patent to be reissued. If an original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the claims allowable over the art, the omitted limitation relates to subject matter previously surrendered by applicant. The reliance by applicant to define the original patent claims over the art can be by way of presentation of new/amended claims to define over the art, or an argument/statement by applicant that a limitation of the claim(s) defines over the art. To determine whether such reliance occurred, the examiner must review the prosecution history of the original application file (of the patent to be reissued) for recapture. The prosecution history includes the rejections and applicant's arguments made therein. If there was no surrender of subject matter made in the prosecution of the original application, again the analysis ends and there is no recapture.

(B) If there was a surrender of subject matter in the original application prosecution, it must then be determined whether any of the broadening of the reissue claims is in the area of the surrendered subject matter. All of the broadening aspects of reissue claims must be analyzed to determine if any of the omitted/broadened limitation(s) are directed to limitations relied upon by applicant in the original application to make the claims allowable over the art.

2. Examples of the *Pannu* Second Step Analysis:

(A) Example (1) - Argument without amendment:

In *Hester, supra*, the Federal Circuit held that the surrender which forms the basis for impermissible recapture "can occur through arguments alone". 142 F.3d at 1482, 46 USPQ2d at 1649. For example, assume that limitation A of the patent claims is omitted in the reissue claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. If the omitted limitation A was argued in the original application to make the application claims

allowable over the art in the application, then the omitted limitation relates to subject matter previously surrendered in the original application, and recapture will exist. Accordingly, where claims are broadened in a reissue application, the examiner should review the prosecution history of the original patent file for recapture, even where the claims were never amended during the prosecution of the application which resulted in the patent.

Note: The argument that the claim limitation defined over the rejection must have been specific as to the limitation relied upon, rather than a general statement regarding the claims as a whole. A general "boiler plate" sentence in the original application will not, by itself, be sufficient to establish surrender and recapture.

An example of a general "boiler plate" sentence of argument is:

"In closing, it is argued that the limitations of claims 1-7 distinguish the claims from the teachings of the prior art, and claims 1-7 are thus patentable."

An argument that merely states that all the limitations of the claims define over the prior art will also not, by itself, be sufficient to establish surrender and recapture. An example is:

"Claims 1-5 set forth a power-train apparatus which comprises the combination of A+B+C+D+E. The prior art of record does not disclose or render obvious a motivation to provide for a material-transfer apparatus as defined by the limitations of claim 1, including an A member and a B member, both connected to a C member, with all three being aligned with the D and E members."

This statement is simply a restatement of the entirety of claim 1 as allowed. No measure of surrender could be gleaned from such a statement of reasons for allowance. See *Ex parte Yamaguchi*, 61 USPQ2d 1043 (Bd. Pat. App. & Inter. 2001)(reported but unpublished, precedential).

In both of the above examples, the argument does not provide an indication of what specific limitations, e.g., specific element or step of the claims, cooperative effect, or other aspect of the claims, are being relied upon for patentability. Thus, applicant has not surrendered anything.

(B) Example (2) - Amendment of the claims without argument:

The limitation omitted in the reissue claim(s) was added in the original application claims for the purpose of making the application claims allowable over a rejection or objection made in the application. Even though applicant made no argument on the record that the limitation was added to obviate the rejection, the nature of the addition to the claim can show that the limitation was added in direct reply to the rejection. This too will establish the omitted limitation as relating to subject matter previously surrendered. To illustrate this, note the following example:

The original application claims recite limitations A+B+C, and the Office action rejection combines two references to show A+B+C. In the amendment replying to the Office action, applicant adds limitation D to A+B+C in the claims, but makes no

argument as to that addition. The examiner then allows the claims. Even though there is no argument as to the addition of limitation D, it must be presumed that the D limitation was added to obviate the rejection. The subsequent deletion of (omission of) limitation D in the reissue claims would be presumed to be a broadening in an aspect of the reissue claims related to surrendered subject matter. Accordingly, the reissued claims would be barred by the recapture doctrine.

The above result would be the same whether the addition of limitation D in the original application was by way of applicant's amendment or by way of an examiner's amendment with authorization by applicant.

(C) Example (3) - Who can make the surrendering argument?

Assume that the limitation A omitted in the reissue claims was present in the claims of the original application. The examiner's reasons for allowance in the original application stated that it was that limitation A which distinguished over a potential combination of references X and Y. Applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue.

Ex parte Yamaguchi, supra, held that a surrender of claimed subject matter cannot be based solely upon an applicant's failure to respond to, or failure to challenge, an examiner's statement made during the prosecution of an application. Applicant is bound only by applicant's revision of the application claims or a positive argument/statement by *applicant*. An applicant's failure to present on the record a counter statement or comment as to an examiner's reasons for allowance does not give rise to any implication that applicant agreed with or acquiesced in the examiner's reasoning for allowance. Thus, the failure to present a counter statement or comment as to the examiner's statement of reasons for allowance does not give rise to any finding of surrender. **The examiner's statement of reasons for allowance in the original application cannot, *by itself*, provide the basis for establishing surrender and recapture.**

It is only in the situation where applicant does file comments on the statement of reasons for allowance, that surrender may have occurred. Note the following two scenarios in which an applicant files comments:

Scenario 1- There is Surrender. The examiner's statement of reasons for allowance in the original application stated that it was limitation C (of the combination of ABC) which distinguished over a potential combining of references X and Y. In that limitation C provided increased speed to the process. Applicant filed comments on the examiner's statement of reasons for allowance essentially supporting the examiner's reasons. The limitation C is thus established as relating to subject matter previously surrendered.

Scenario 2- There is No Surrender. On the other hand, if applicant's comments on the examiner's statement of reasons for allowance contain a counter statement that it is limitation B (of the combination of ABC), rather than C, which distinguishes the claims over the art, then limitation B would constitute surrendered subject matter, and limitation C has not been surrendered.

C. The Third Step - Were the reissued claims materially narrowed in other respects to compensate for the broadening in the area of surrender, and thus avoid the recapture rule?

As pointed out above, the third prong of the recapture determination set forth in *Pannu* is directed to analysis of the broadening and narrowing effected via the reissue claims, and of the significance of the claim limitations added and deleted, using the prosecution history of the patent (to be reissued), to determine whether the reissue claims should be barred as recapture.

The following discussion addresses analyzing the reissue claims, and *which claims* are to be compared to the reissue claims in determining the issue of surrender (for reissue recapture).

When analyzing a reissue claim for the possibility of impermissible recapture, there are two different types of analysis that must be performed. If the reissue claim "fails" either analysis, recapture exists.

First, the reissue claim must be compared to any claims canceled or amended during prosecution of the original application. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution to define over the art. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue. *In re Clement, supra*.

Second, it must be determined whether the reissue claim entirely omits any limitation that was added/argued during the original prosecution to overcome an art rejection. Such an omission in a reissue claim, even if it includes other limitations making the reissue claim narrower than the patent claim in other aspects, is impermissible recapture. *Pannu v. Storz Instruments Inc., supra*. However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine. *Ex Parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential). For example, if the key limitation added to overcome an art rejection was "an orange peel," and the reissue claim instead recites "a citrus fruit peel", the reissue claim may not be rejected on recapture grounds.

The following discussion is provided for analyzing the reissue claims.

1. Comparison of Reissue Claims Narrowed/Broadened *Vis-à-vis* the Canceled Claims

DEFINITION: "Canceled claims," in the context of recapture case law, are claims canceled from the original application to obtain the patent for which reissue is now being sought. The claims

(A) can simply be canceled and not replaced by others, or

(B) can be canceled and replaced by other claims which are more specific than the

canceled claims in at least one aspect (to thereby define over the art of record). The "replacement claims" can be new claims which are narrower than the canceled claims, or can be the same claims amended to be narrower than the canceled version of the claims.

(a) Reissue Claims are Same or Broader in Scope Than Canceled Claims in All Aspects:

The recapture rule bars the patentee from acquiring, through reissue, claims that are in all aspects (A) of the same scope as, or (B) broader in scope than, those claims canceled from the original application to obtain a patent. *In re Ball Corp. v. United States*, 729 F.2d at 1436, 221 USPQ at 295.

(b) Reissue Claims are Narrower in Scope Than Canceled Claims in at Least One Aspect:

If the reissue claims are equal in scope to, or narrower than, the claims of the original patent (as opposed to the claims "canceled from the application") in all aspects, then there can never be recapture. The discussion that follows is not directed to that situation. It is rather directed to the situation where the *reissue claims are narrower than the claims "canceled" from the application in some aspect, but are broader than the claims of the original patent in some other aspect.*

If the reissue claims are narrower in scope than the claims canceled from the original application by inclusion of the limitation added to define the original application claims over the art, there will be no recapture, even if the reissue claims are broader than the canceled claims in some other aspect (i.e., an aspect not related to the surrender made in the original application).

Assume combination AB was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABC (after which the patent issued). The reissue claims are then directed to combination AB

broadened

C. The AB

broadened

C claims are *narrower* in scope when compared with the canceled claim subject matter AB *in respect to the addition of C* (which was added in the application to overcome the art), and there is no recapture.

As another example, assume combination ABZ was originally presented in the application, and was amended in response to an art rejection to add element C and thus provide ABZC (after which the patent issued). The reissue claims are then directed to combination ABC (i.e., element Z is deleted from the canceled claims, while element C remains present). The ABC claims of the reissue are *narrower* in scope as compared to the canceled-from-the-original-application claim subject

matter ABZ *in respect to the addition of C* (which was added in the application to overcome the art), and there is thus no recapture.

2. Comparison of Reissue Claims Narrowed/Broadened *Via-à-vis* the Patent Claims

The "patent claims," in the context of recapture case law, are claims which issued in the original patent for which reissue is now being sought. As pointed out above, where the reissue claims are narrower than the claims of the original patent in all aspects, then there can never be recapture. If reissue claims are equal in scope to the patent claims, there is no recapture as to those reissue claims. Where, however, reissue claims are both broadened and narrowed as compared with the original patent claims, the nature of the broadening and narrowing must be examined to determine whether the reissue claims are barred as being recapture of surrendered subject matter. If the claims are "broader than they are narrower in a manner directly pertinent to the subject matter... surrendered during prosecution" (*Clement*, 131 F.3d at 1471, 45 USPQ2d at 1166), then recapture will bar the claims. This narrowing/broadening *vis-à-vis* the patent is broken down into four possibilities that will now be addressed.

The "limitation" presented, argued, or stated to make the claims patentable over the art (in the application) "generates" the surrender of claimed subject matter. For the sake of simplification, this limitation will be referred to throughout this section as the surrender-generating limitation. If a claim is presented in a reissue application that omits, in its entirety, the surrender-generating limitation, that claim impermissibly recaptures what was previously surrendered, and that claim is barred under 35 U.S.C. 251. This terminology will be used in the discussion of the four categories of narrowing/broadening *vis-à-vis* the patent that follows.

(a) Reissue Claims are Narrower in Scope Than Patent Claims, in Area Not Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope by Omitting Limitation(s) Added/Argued To Overcome Art Rejection in Original Prosecution:

In this case, there is recapture.

This situation is where the patent claims are directed to combination ABC and the reissue claims are directed to ABD. Element C was either a limitation added to AB to obtain allowance of the original patent, or was argued by applicant to define over the art (or both). Thus, addition of C (and/or argument as to C) has resulted in the surrender of any combination of A & B that does not include C; this is the surrendered subject matter. Element D, on the other hand, is not related to the surrendered subject matter. Thus, the reissue claim, which no longer contains C, is broadened in an area related to the surrender, and the narrowing via the addition of D does not save the claim from recapture since D is not related to the surrendered subject matter.

Reissue claims that are broader than the original patent claims by not including the surrender-generating limitation (element C, in the example given) will be barred by the recapture rule even though there is narrowing of the claims not related to the surrender-generating limitation. As stated in the decision of *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane

to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Pannu v. Storz Instruments Inc.*, *supra*, then brings home the point by providing an actual fact situation in which this scenario was held to be recapture.

(b) Reissue Claims are Narrower or Equal in Scope, In Area Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope in Area Not Directed to Amendment/Argument:

In this case, there is no recapture.

This situation is where the patent claims are directed to combination ABCDE and the reissue claims are directed to ABDE (element C is omitted). Assume that the combination of ABCD was present in the original application as it was filed, and element E was later added to define over that art. No argument was ever presented as to elements A-C defining over the art.

In this situation, the ABCDE combination of the patent can be broadened (in the reissue application) to omit element C, and thereby claim the combination of ABDE, where element E (the surrender generating limitation) is not omitted. There would be no recapture in this instance. (If an argument had been presented as to element C defining over the art, in addition to the addition of element E, then the ABCDE combination could not be broadened to omit element C and thereby claim combination of ABDE. This would be recapture; see the above discussion as to surrender and recapture based upon argument.)

Additionally, the reissue claims are certainly permitted to recite combination ABDE
specific

(where surrender-generating element E is narrowed). The patent claims have been broadened in an area not directed to the surrender (by omitting element C) and narrowed in the area of surrender (by narrowing element E to E

specific

). This is clearly permitted.

As another example, assume limitation C was added to application claims AB to obtain the patent to ABC, and now the reissue application presents claims to AC or AB

broad

C. Such reissue claims avoid the effect of the recapture rule because they are broader in a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). Such claims are considered to be broader in an aspect not "germane to a prior art rejection," and thus are not barred by recapture. Note *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

Reissue claims that are broader than the original patent claims by deletion of a limitation or claim requirement other than the "surrender-generating limitation" will avoid the effect of the recapture rule, regardless of the nature of the narrowing in the claims, and even if the claims are not narrowed at all from the scope of the patent claims.

(c) Reissue Claims are Narrower in Scope in Area Not Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; are Broader in Scope in Area Not Directed to the Amendment/Argument:

In this instance, there is clearly no recapture. In the reissue application, there has been no change in the claims related to the matter surrendered in the original application for the patent.

In this instance, element C was added to the AB combination to provide ABC and define over the art, and the patent was issued. The reissue omits element B and adds element Z, to thus claim ACZ. There is no recapture since the surrender generating element C has not been modified in any way. (Note, however, that if, when element C was added to AB, applicant argued that the association of newly added C with B provides a synergistic (unexpected) result to thus define over the art, then neither B nor C could be omitted in the reissue application.)

(d) Reissue Claims Broader in Scope in Area Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; but Reissue Claims Retain, in Broadened Form, the Limitation(s) Argued/Added to Overcome Art Rejection in Original Prosecution:

Assume the combination AB was originally claimed in the application, and was amended in reply to an art rejection to add element C and thus provide the combination ABC (after which the patent issued). A reissue application is then filed, and the reissue application claims are directed to the combination ABC

broadened

. The ABC

broadened

claims are narrowed in scope when compared with the canceled claim subject matter AB, because of the addition of C

broadened

. Thus, the claims retain, in broadened form, the limitation argued/added to overcome art rejection in original prosecution. There is no recapture, since ABC

broadened

is narrower than canceled claim subject matter AB in an area related to the surrender. This is so, because it was element C that was added in the application

to overcome the art. See *Ex Parte Eggert*, *supra*.

II. REISSUE TO TAKE ADVANTAGE OF 35 U.S.C. 103(b):

A patentee may file a reissue application to permit consideration of process claims which qualify for 35 U.S.C. 103(b) treatment if a patent is granted on an application entitled to the benefit of 35 U.S.C. 103(b), without an election having been made as a result of error without deceptive intent. See MPEP § 706.02(n). **This is not to be considered a recapture.** The addition of process claims, however, will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

III. REISSUE FOR ARTICLE CLAIMS WHICH ARE FUNCTIONAL DESCRIPTIVE MATERIAL STORED ON A COMPUTER-READABLE MEDIUM:

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims to this statutory category of invention (the "article" claims) must have been made as a result of error without deceptive intent. The addition of these "article" claims will generally be considered to be a *broadening* of the invention (*Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989)), and such addition must be applied for within two years of the grant of the original patent. See also MPEP § 1412.03 as to broadened claims.

IV. REJECTION BASED UPON RECAPTURE:

Reissue claims which recapture surrendered subject matter should be rejected using form paragraph 14.17.

¶ 14.17 Rejection, 35 U.S.C. 251, Recapture

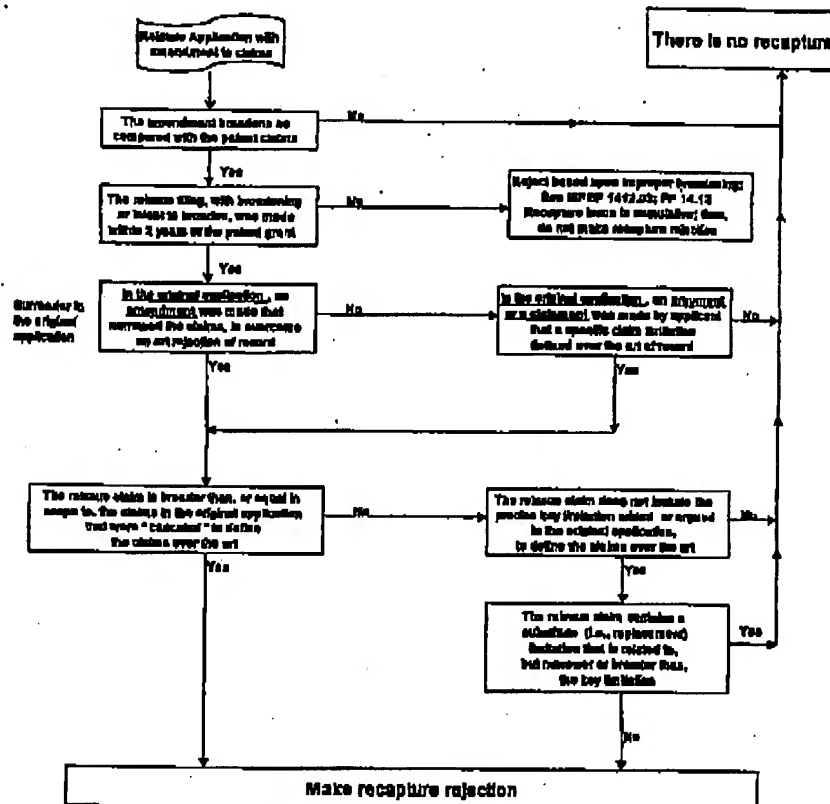
Claim[1] rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

[2]**Examiner Note**

In bracket 2, the examiner should explain the specifics of why recapture exists, including an identification of the omitted/broadened claim limitations in the reissue which provide the "broadening aspect" to the claim(s), and where in the original application the narrowed claim scope was presented/argued to obviate a rejection/objection. See MPEP § 1412.02.

See the recapture-analysis flow chart which follows for assistance in determining whether recapture is present, consistent with the case law discussed above.

Reissue Recapture - Determining its presence or absence



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1412.02 Recapture of Canceled Subject Matter [R-5] - 1400 Correction of Patents

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